

General Remarks

Applicant has considered the outstanding Office action. It is respectfully submitted that the claims are directed to patentable subject matter as set forth below.

Applicant has added new claims 23, 24 and 25. No new matter has been introduced.

Claims 1-14 are objected to for including informalities. Applicant has addressed the matters raised by Examiner by amending the claims as suggested by the Examiner. Withdrawal of the objection is respectfully requested.

Claims 15-21 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, the Examiner states that in claim 15 “the word ‘means’ is not preceded by any word(s) in an attempt to use a ‘means’ clause to recite a claim element as a means of performing a specified function,” and thus, “it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph.” Applicant respectfully traverses the rejection.

Traversal of §112 Rejections

In support of the §112 rejection, the Examiner relies on the findings of the Board of Patent Appeals and Interferences set out in Ex parte Klumb, 159 USPQ 694 (Bd. App. 1967). However, the decision of the Board in Klumb does not support the Examiner’s rejection, but rather contradicts it. More particularly, the Board in Klumb stated that there is no necessity to construe §112 to require a particular grammatic construction in means clauses in patent claims so long as the modifier of the structureless term “means” specifies a function to be performed. The Board of Appeals went on to state that the expression “means for printing” is in conformity with the statute. In the present application, all of Applicant’s “means” terms are followed and properly modified by a specific function, e.g., means for supporting a SINCGARS radio, and mirror the arrangement of the expression “means for printing,” which expression has been found to be in accord with the Patent Laws. In view of the Board’s decision in Klumb, withdrawal of the §112 rejection is respectfully requested.

Traversal of §103 Rejections

The Examiner has a burden to make out a *prima facie* case of obviousness by pointing out with particularity any equivalent elements disclosed by cited references that indicate to the Applicant where the combination of such elements would have been taught or suggested by the prior art. *ACS Hospital System, Inc. v. Monte Fiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1994). Further, the mere fact that the prior art can be modified to arrive at the claimed invention does not make the modification obvious unless the prior art suggests the desirability of the modification. *In re Gordon* 221 USPQ 1125, 1127 (Fed. Cir. 1984). Applicant submits that no teaching or suggestion for combining the cited elements has been set forth by the Examiner as required by known case law.

Claims 1, 2, 9, 11, 15 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shin et al. (U.S. Patent No. 5,604,663). Applicant respectfully submits that a prima facie case of obviousness has not been set forth because Shin et al. fail to teach or suggest each and every element of the claimed invention. *See In re Royka*, 490 F.2d 981, 108 USPQ 580 (CCPA 1974)(“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art”). Further, there has been no showing by the Examiner that Shin et al. suggests in some way a modification of the reference to arrive at the claimed invention, and thus the Examiner’s burden of establishing a prime facie case of obviousness has not been met. *See In re Piasecki*, 745 F.2d 1468, 223 USPQ 758 (Fed. Cir. 1985)(It is the burden of the examiner to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103). Accordingly, withdrawal of the §103(a) rejection is respectfully requested.

As set out in sole independent claims 1, 15 and 22, the claimed invention is directed to an apparatus for supplying power to a SINCGARS radio. According to claims 1 and 22, the apparatus includes a base platform adapted and arranged for holding or supporting a SINCGARS radio, the base platform having a front side, a rear side and an integral rear portion extending

upward from the rear side of the base platform; at least one electrical connector or socket adapted to fit a complementary connector or socket on the SINCGARS radio is positioned on the rear portion; and a power supply adapted and arranged for supplying power to the SINCGARS radio contained within the base platform in electrical contact with the at least one electrical connector or socket. Claim 15 recites a “supporting means” for supporting a SINCGARS radio in place of the platform recited in claims 1 and 22, with the supporting means further limited by “an integral rear portion extending upward from the supporting means.” Claim 15 recites an “electrical connecting means” in place of an electrical socket or connecting which is held by the rear portion for electrically connecting the apparatus to the SINCGARS radio, and an electrical power providing means is recited that provides electrical power to the SINCGARS radio through the electrical connecting means.

Shin et al. discloses a portable computer docking station 20 including a base 22 configured to support a portable computer, an electrical connector 26 configured for electronically connecting to a portable computer and a rotatable member 24, rotatable member 24 and electrical connector 26 being attached to base 22. According to Shin et al., rotatable member 24 includes a rear face 30 for urging against a portable computer in a locking position with respect to base 22. In the locking position, rotatable member 24 extends perpendicularly from base 22, and a pair of latches 34 extend from the top of base 22 for securing the portable computer thereto.

However, Shin et al. fail to disclose any elements equivalent to the above recited elements for claims 1, 15, and 22, and the Examiner has not pointed out or shown any suggestion or teaching in Shin to modify the purported equivalent elements of Shin to arrive at the recited elements in the claimed invention. Specifically, base 22 of Shin et al. is configured to support a portable computer, not a SINCGARS radio, and the base 22 is not adapted or configured to accommodate a radio. The disclosed Shin base 22 includes rotatable member 24 for urging the base against a portable computer, and pair of latches 35 extending from the top of base 22 for

securing a portable computer thereto. There has been no showing by the Examiner or otherwise that rotatable member 24 and pair of latches 35 are adapted and arranged in relation to base 22 or one another for supporting a SINCGARS radio. In fact, the configuration of base 22 of Shin et al. teaches away from the claimed invention since the claimed base platform and supporting means cannot include latches as taught by Shin et al. without rendering the claimed platform base and supporting means incapable of receiving a SINCGARS radio. That is, the upward extending pair of latches as taught by Shin et al. would get in the way of a SINCGARS radio and thereby prevent the SINCGARS radio from being secured to the claimed SINCGARS power supply. Moreover, if the base 22 of Shin et al. was modified to remove the pair of latches 35 or alter the configuration of rotatable member 24 to accept a SINCGARS radio, or any radio for that matter, the purpose of base 22 and ultimately the computer docking station 20 would be destroyed since base 22 and docking station 20 could no longer secure a portable computer thereto. Thus, there is a disincentive, not motivation, to modify the teachings of Shin et al. to arrive at the claimed invention. *See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)(when a modification to a reference to arrive at a claimed invention destroys the intended function of the reference, a rejection under §103 is improper).

Similarly, in contrast to the claimed electrical connector, socket or electrical connecting means of claims 1, 15, and 22, each being adapted to fit a complementary connector or socket on the SINCGARS radio, Shin et al. teach an electrical connector 26 configured for electronically connecting to a portable computer. An electrical connector for electronically connecting to a portable computer is not suitable to fit a power connector on a SINCGARS radio. Further, there has been no showing by the Examiner or otherwise that electrical connector 26 is adapted and arranged to fit a complementary connector or socket on a SINCGARS radio or that Shin et al. in some way suggests a modification to the connector to fit a radio. Radios and computers have vastly different electrical requirements and connectors for each are designed differently. Moreover, Shin teaches a connector for communicating computer data to the docking station. In

the instant invention, no computer data is transferred to a radio, such as a SINCGARS radio, and the shape, size, and function of the Shin connector is highly dissimilar as compared to the recited connector because of these different electrical requirements. Therefore, the electrical connector disclosed by Shin is not equivalent to the recited connector and no incentive for modification of the Shin into a connector for a radio has been shown. *Id. In re Gordon.*

Finally, the power supply element recited in each claim 1, 15, and 22 is not equivalent to the Shin disclosed power supply. The electrical supply requirements for a notebook computer, as disclosed in Shin, and a SINCGARS radio are very dissimilar. Size, shape, power output, and AC to DC conversion requirements are all different between the two devices. Making any modifications to any of these characteristics in the Shin power supply to meet the requirements of a radio, such as a SINCGARS radio, would render the Shin power supply useless for notebook computer power purposes. Therefore, no incentive would result for the Shin docking station power supply to be modified into a radio power supply and, again, such a modification would destroy the intended purpose of the Shin power supply. *Id. In re Gordon.*

In summary, there is no teaching or suggestion in Shin et al. for a base platform, connector or power supply, as recited in claim 1, 15, and 22, nor is there any teaching or suggestion to modify the purported equivalent elements disclosed in Shin et al. to arrive at the claimed invention. Moreover, the Examiner has not made any such arguments.

For reasons set out above, withdrawal of the §103(a) rejection is respectfully requested because a prima facie case of obviousness under §103(a) has not been set forth. The Examiner relies solely on the disclosure in Shin et al. to support the rejection under §103(a). However, as shown above, each of the elements of the independent claims of the application, namely claims 1, 15 and 22, are not taught or suggested by Shin et al., and Shin et al. makes no reference whatsoever to any type of radio or to modifying the disclosed portable computer docking station 20 to accept a SINCGARS radio. Thus, in order for the Examiner to assert that Shin et al. teaches or suggests the claimed invention, the Examiner must rely on the skill in the art

component to modify the teaching of Shin et al. to arrive at the claimed invention. However, the U.S. Court of Appeals for the Federal Circuit has stated that, “rarely...will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment.” Al-Site Corp. v. VSI International, Inc., 174 F.3d 1308 (Fed. Cir. 1999). “To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art references of record convey or suggest that knowledge, is to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher.” W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983). Accordingly, applicant respectfully submits that the claimed invention is not rendered obvious within the meaning of 35 U.S.C. §103 and applicant submits that the Examiner has adopted a hindsight view to arrive at the claimed invention.

Claims 3-7, 10, 12 and 16-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shin et al. in view of Choo (U.S. Patent No. 6,163,086), and claims 8, 13, 20 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shin et al., Choo and further in view of Thomsen (U.S. Patent No. 6,491,278). Applicant respectfully traverses the rejections.

Applicant incorporates by reference here and reasserts all of the arguments set forth above regarding the §103 rejection for claims 1, 15 and 22, and notes that each of claims 3-7, 10, 12 and 16-19 and claims 8, 13, 20 and 21 are dependent from these independent claims. Thus, since the cited secondary references (Choo and Thomsen) are only relied on for teaching the additional limitations of the noted dependent claims, applicants submit that claims 3-7, 10, 12 and 16-19 and claims 8, 13, 20 and 21 are also directed to patentable subject matter as set forth above. Further, neither of the secondary references teach the claimed base platform, the claimed at least one electrical connector or socket, the claimed power supply, the claimed supporting means, the claimed electrical connecting means or the claimed electrical power providing means. Accordingly, withdrawal of the §103(a) rejection is respectfully requested.

Conclusion

Therefore, Applicant submits that all of the rejected claims, namely claims 1-22, and new claims 23-25, are not obvious in light of the cited references, as applied by the Examiner under 35 U.S.C. §103, and that §112 of the patent laws has been misapplied. In light of the arguments set forth above by the Applicant and further in light of the cited case law, Applicant submits that the application is in a condition for allowance and respectfully request reconsideration and withdrawal of the cited rejections and favorable acceptance of the herein submitted claim alterations. Applicant encourages the Examiner to contact the undersigned should further discussions be fruitful for assisting the Examiner in his examination and to facilitate the application moving along to a condition of allowance and patenting.

Respectfully submitted,

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